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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/585,067

06/29/2006

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EXAMINER

BUIE, NICOLE M

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

05/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/585,067	Applicant(s) TANAKA ET AL.	
	Examiner NICOLE M. BUIE	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment filed 02/24/2009 has been entered. Claims 1-7 have been canceled. Claims 8-15 have been added. The previous claim objection to claims 1-7 is withdrawn in light of Applicants' cancellation of said claims.

Response to Arguments

Applicant's arguments filed 02/24/2009 with respect to claims 1-7 have been fully considered and are persuasive. The rejection of claims 1-7 has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art.

The following comments apply:

A) Since, Stewart (US 4,503,171) does not teach or suggest a crystalline carbon allotrope, the previous rejection under Stewart has been withdrawn.

B) Since JP 2004-051937 A does not teach or suggest a fluorine-containing elastomer, the previous rejection under 102(a) of claims 1-5 have been withdrawn.

C) Since claim 12 is the same as previous claim 2 and newly found prior art has been used, this action is not final.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8, 9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Savinkin et al. (RU 2164524 C1, see Derwent Abstract for citation) as evidenced by Guschin et al. (US 5,482,695).

Regarding claims 8 and 9, Savinkin et al. discloses a fluorine-containing elastomer comprising a fluorine-containing elastomer and impact detonation diamond graphite which is used for a coating (See Derwent Abstract).

However, Savinkin et al. does not explicitly disclose the particle size of impact detonation diamond graphite. As evidenced by Guschin et al., the size of the diamond after detonation is from 0.004-0.012 μm which meets the claimed range (C1/L21-25, C2/L1-10).

Regarding claim 11, the recitation of a new intended use (i.e. for a semiconductor manufacturing equipment) for an old product does not make a claim to that old product patentable. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). See MPEP § 2111.02.

Claims 12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Savinkin et al. (RU 2164524 C1, see Derwent Abstract for citation) as evidenced by Guschin et al. (US 5,482,695).

Regarding claims 12 and 14, Savinkin et al. discloses a fluorine-containing elastomer comprising a fluorine-containing elastomer and impact detonation diamond graphite which is used for a coating (See Derwent Abstract).

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However, Savinkin et al. does not explicitly disclose the particle size of impact detonation diamond graphite. As evidenced by Guschin et al., the size of the diamond after detonation is from 0.004-0.012 μm which meets the claimed range (C1/L21-25, C2/L1-10).

Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Guschin et al. (US 5,482,695).

Regarding claim 15, Guschin et al. discloses diamond particles are 0.04-0.012 μm which meets the claimed range (C2/L1-10).

The recitation of a new intended use (i.e. for a sealing material in a semiconductor manufacturing equipment) for an old product does not make a claim to that old product patentable. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). See MPEP § 2111.02.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Savinkin et al. (RU 2164524 C1, see Derwent Abstract for citation) as evidenced by Guschin et al. (US 5,482,695) as applied to claims 8 and 12 above, and further in view of Drobny "Technology of Fluoropolymers", 2001, CRC Press, , pp. 103-104.

Regarding claim 10, modified Savinkin et al. discloses a coating material as shown above in claims 8 and 12.

However, modified Savinkin et al. does not disclose fluorine-containing elastomer is a perfluoroelastomer. Drobny teaches perfluoroelastomers are useful as coatings or sealants (P103-104). Savinkin et al. and Drobny are analogous art concerned with the same field of endeavor, namely fluoroelastomeric material for coatings. It would have been obvious to one of ordinary skill in the art at the time of invention to substitute a fluorine-containing elastomer of Savinkin et al. with a perfluoroelastomer of Drobny, and the motivation to do so would have been as Drobny suggests perfluoroelastomers are particularly suited for extreme service conditions, including chemical substances, oxidizers, oils, fuels, acids, and are capable of use at high temperatures (P103).

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Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLE M. BUIE whose telephone number is (571)270-3879. The examiner can normally be reached on Monday-Thursday with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571)272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. M. B./
Examiner, Art Unit 1796
5/21/2009

/Marc S. Zimmer/

Primary Examiner, Art Unit 1796